No. 99-1066

IN THE

Supreme Court of the United States

JOHNNY BLASTOFF, INC.,

Petitioner,

v.

LOS ANGELES RAMS FOOTBALL COMPANY, ST. LOUIS RAMS PARTNERSHIP, NATIONAL FOOTBALL LEAGUE PROPERTIES, INC. and NATIONAL FOOTBALL LEAGUE,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION

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STATEMENT PURSUANT TO RULE 29.6

St. Louis Rams Football Company, Inc., a corporation organized under the laws of the State of Delaware, is the successor in interest to named Respondent Los Angeles Rams Football Company. St. Louis Rams Partnership is a Delaware general partnership, composed of St. Louis Rams Football Company, Inc. National Football League Properties, Inc. is a California corporation owned in equal parts by each of the thirty-two (32) Member Clubs of the National Football League (the "NFL"). The NFL is a New York unincorporated association.

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STATEMENT OF THE CASE

Respondents, Los Angeles Rams Football Company, St. Louis Rams Partnership (together, the "Rams" or the "Rams Club"), National Football League Properties, Inc. ("NFLP") and National Football League (the "NFL") (collectively, "Respondents"), are the prior users of the trademark ST. LOUIS RAMS. Petitioner Johnny Blastoff, Inc. ("Petitioner") has claimed that its intent-to-use trademark application somehow granted it rights superior to those of Respondents. The District Court for the Western District of Wisconsin correctly applied established precedent to the particular facts of this case and properly dismissed Petitioner's claims and granted Respondents' counterclaims on summary judgment. The Court of Appeals for the Seventh Circuit reviewed the decision below *de novo* and affirmed, in a well-reasoned opinion based upon traditional trademark law principles. Notwithstanding the argumentative, inaccurate and irrelevant "facts" and strained legal theories advanced by Petitioner, as demonstrated in the lower courts' opinions, this is a routine trademark dispute that presents no novel legal issues, and creates no conflict with federal trademark legislation or decisions in other Circuits. Accordingly, this Court should deny the Petition for a writ of certiorari.

An accurate account of the salient facts in this matter, as found by the Court of Appeals and the District Court, is contained in the Appendix to the Petition ("App.") at pages A-3 through A-8 and A-31 through A-43. Briefly stated, beginning at least as early as December 1993 and continuing through 1994, newspaper articles in the St. Louis area reported on the possible relocation of the Los Angeles Rams, a Member Club of the NFL, to St. Louis. App. at A-5, A-34.

By late 1994, a "St. Louis Rams Fan Club" was formed at a St. Louis sports bar. *Id.* On January 17, 1995 Georgia Frontiere, owner of the Los Angeles Rams, held a press conference in St. Louis with Mayor Freeman Bosley at which time the intent to move the Rams to St. Louis was announced. *Id.* at A-5, A-11, A-34. The press conference received significant local and national press coverage, resulting in articles in *USA Today* and the *New York Times*, among others. *Id.* Mayor Bosley was quoted in the *New York Times* as referring to the team as the "St. Louis Rams". *Id.* The January 18, 1995 edition of the *St. Louis Post-Dispatch* included a 16-page pull-out section devoted to the Rams football team, entitled "St. Louis Rams". *Id.* Immediately after the press conference, the Rams club began advertising the sale of "personal seat licenses."[1] By early February 1995, the Rams Club had received more than 72,000 applications for PSLs. *Id.* at A-5-6, A-11-12, A-35-36. Also in January 1995, vendors began selling unauthorized "St. Louis Rams" merchandise and NFLP sent cease and desist letters to these vendors, thereby enforcing the trademark rights of the Rams. *Id.* at A-6, A-12, A-35. Based on these undisputed facts, the Seventh Circuit determined that by February of 1995 a significant portion of the public associated the mark ST. LOUIS RAMS with Respondents. *Id.* at A-12.

Aware of the Rams' announced plan to move to St. Louis, on March 10, 1995 Petitioner filed an intent to use application to register "ST. LOUIS RAMS" in the United States Patent and Trademark office. The Seventh Circuit correctly found that Petitioner's prior activities: (1) development of a "Tower City Rams" design which did not include any reference to the mark St. Louis Rams, and (2) production of a single swatch of material

1. These personal seat licenses ("PSLs") granted holders the right to acquire season tickets for home games of the Rams club in the new domed stadium then under construction in St. Louis.

embroidered with "ST. LOUIS RAMS", were insufficient to establish any public association between the alleged mark and Petitioner or its products. *Id.* at A-12-13.

These undisputed facts compelled the conclusion by both the District Court and the Seventh Circuit that Respondents acquired protectable rights in the mark ST. LOUIS RAMS before Petitioner filed its application for registration or engaged in any commercial use of the designation. The Court of Appeals denied Petitioner's application for rehearing. *Id.* at A-74.

REASONS FOR DENYING THE WRIT

As an initial matter, Petitioner has not complied with the procedural rules of this Court. Furthermore, Petitioner's application for a writ of certiorari should also be denied on substantive grounds. Petitioner asserts various spurious "conflicts" and "clashes" between the Seventh Circuit's decision, and the decisions of other courts and the Lanham Trademark Act (15 U.S.C. § 1051-1127) (as amended in 1989). The Seventh Circuit's decision, however, fits squarely within the principles embodied in the Lanham Act and established trademark law precedent, and presents no important federal question that merits this Court's review.

I. PETITIONER HAS NOT COMPLIED WITH THIS COURT'S RULES GOVERNING PETITIONS FOR CERTIORARI.

The Petition in this matter was first filed with the Court on November 24, 1999, and was rejected by the Court by letter dated November 26, 1999, due to procedural deficiencies. The amended Petition, however, filed with the

Court on December 17 and docketed shortly thereafter, incorporates numerous substantive changes from the first submission. Petitioner has therefore evaded this Court's strict filing deadlines by using an extension of time to correct *procedural* defects to make material, *substantive* changes to its Petition. For example, Petitioner substantially revised and added to the "Questions Presented", the "Statement of the Case" and the "Reasons for Granting the Writ" sections of his Petition. Specifically, Petitioner used the extension of time to revise Questions 4 and 5, to add sub-questions viii through xii to Question 6, to add Questions 7 and 8, to revise the arguments presented in paragraphs numbered H and P, and to add arguments paragraph numbered W, X, Y, Z, AA, and BB to the Petition. Even before reaching the substantive flaws in the Petition as addressed below, the Writ should be denied on this procedural basis alone.

II. THE SEVENTH CIRCUIT'S DECISION CREATES NO CONFLICT AMONG THE CIRCUIT COURTS OF APPEAL.

There is no conflict between the Seventh Circuit's decision in this matter and the Third Circuit's decision in *Lucent Info. Management, Inc. v. Lucent Techs. Inc.*, 186 F.3d 311 (3d Cir. 1999). As recognized by the *Lucent* court, and consistent with at least a century of precedent, exclusive trademark rights are based on priority of use. *Id.* at 315; *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *see* Lanham Act Section 7(c), 15 U.S.C. § 1057(c) ("the filing of [an] application to register [a mark] shall . . . confer[ ] a right of priority, nationwide in effect, . . . against any other person *except for a person . . . who, prior to such filing, has used the mark.*"). Just as the Court did in *Lucent*, the District Court and Seventh Circuit in this case examined

use of the trademark at issue by one party prior to the filing of an intent to use trademark application by another, to determine whether such use was sufficient to establish priority as a matter of law. 186 F.3d at 315. Both the Seventh Circuit in this case, and the Court of Appeals in *Lucent*, applied the standard accepted across the Circuits: priority resides in the party who is first to establish use "in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark." App. at A-10, quoting *New West Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 1200 (9th Cir. 1979); *Lucent*, 186 F.3d at 315, quoting *Blue Bell, Inc. v. Farah Mfg. Co., Inc.*, 508 F.2d 1260, 1266 (5th Cir. 1975).

The Seventh Circuit properly followed the well-accepted principle that "[t]he determination of whether a party has established protectable rights in a trademark is made on a case by case basis, considering the totality of the circumstances." App. at A-10, citing *New West*, 595 F.2d at 1200. In *Lucent*, the Third Circuit determined that the plaintiff, basing its claim of priority on a single sale of a product to an acquaintance of two officers of the company (*see Lucent*, 186 F.3d at 317), failed to establish trademark rights superior to the intent to use applicant. In stark contrast, Respondents in this case amply demonstrated that prior to Petitioner's application for registration, use of the mark ST. LOUIS RAMS was sufficiently widespread and public that a significant portion of the public identified the designation with the Rams Club. *See* App. at A-12.

III. IN REJECTING PETITIONER'S CLAIMS, THE SEVENTH CIRCUIT RELIED ON TRADITIONAL TRADEMARK LAW PRINCIPLES.

A. The Seventh Circuit's Decision Is Consistent With Seventh Circuit Precedent.

No "clash" exists between the Seventh Circuit's decision in this matter and prior Seventh Circuit precedent.[2] The Court here cited and followed its prior holdings in *Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499 (7th Cir. 1992), and *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership*, 34 F.3d 410 (7th Cir. 1994).

Applying the analysis articulated in *Zazu*, the Court of Appeals found that Respondents were the first to appropriate the mark ST. LOUIS RAMS through use which served to establish the mark as a designation of source. *See* App. at A-10, A-12. Similarly, relying on *Indianapolis Colts*, the Panel found "strong support" for the proposition that Respondents had a long established priority in the name "RAMS" for the same professional football team, "regardless of urban affiliation." App. at A-13. Just as the holding in *Indianapolis Colts* does not prevent others from using "Colts" to designate anything besides the Colts professional football team, the *Blastoff* decision does not preclude others from exploiting the word "Rams", unless it is used in a setting that will lead consumers to believe it designates the Rams professional football team. *See Indianapolis Colts*, 34 F.3d

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2. Of course, even if the Seventh Circuit's decision in this case were not fully consistent with its own prior decisions, no conflict warranting review by this Court would exist. *See* Supreme Court R. 10.

at 416. Key to the courts' decisions in this case that Petitioner itself has conceded a likelihood of confusion between the source of its goods and the Rams Club. App. at A-16, A-19.

The holding that "Rams" is not generic for a professional football team is, likewise, fully consistent with the Seventh Circuit's decision in *Illinois High School Ass'n v. GTE Vantage, Inc.*, 99 F.3d 244 (7th Cir. 1996). In *Illinois High School*, the Court did not find the phrase "March Madness" generic, as a result of dual use. Judge Posner simply held that each of the NCAA and Illinois High School had a legitimate right to use the designation in connection with their respective tournaments. *Id.* at 247. In contrast, a finding of genericness requires proof that the mark is a commonly used term to denote a type of goods. *E.g.*, *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1157 (7th Cir. 1996). Petitioner's claim that "Rams" is generic was correctly dismissed by the Seventh Circuit because Petitioner did not and cannot provide any evidence showing: (i) that "Rams" or "St. Louis Rams" is the common linguistic term for a professional football team; (ii) that the "Rams" or "St. Louis Rams" marks have become a common term for professional football teams generally; or (iii) that any other professional team is known as the Rams (or as the "St. Louis Rams"), except the predecessor Los Angeles Rams. App. at A-20-22.

B. The Trademark Law Revision Act of 1989 Did Not Abolish the Principal That Trademark Rights Spring From Use.

Petitioner's criticism of the Seventh Circuit's reliance on *The Money Store v. Harriscorp Fin., Inc.*, 689 F.2d 666 (7th Cir. 1982), is nonsensical. The Seventh Circuit correctly cited *Money Store* for the unassailable principle that "a trademark application is always subject to previously established common law trademark rights of another party." App. at A-14. Petitioner's suggestion that the Lanham Act amendment permitting applications for trademark registration based on intent to use overruled this principle has no basis in law or fact.

Petitioner asks this Court to rule that the first to file an intent to use application for a federal trademark registration has superior rights as of the filing date of the application, irrespective of prior use by and public association of the mark with another. But the Trademark Law Revision Act, cited repeatedly by Petitioner, did not abolish the use-based foundation of United States trademark law. The intent to use provisions were not designed to encourage or reward a party, like Petitioner, by according prior rights to one who races to file a trademark application after the public has come to associate the mark with another. The rule proposed by Petitioner would create a perverted incentive for trademark squatters. The foundation of United States trademark law is that the exclusive right to a distinctive mark belongs to the party that first uses the mark in commerce to designate the source of its goods or services. The reason that priority of use determines the rights as between conflicting claimants to a mark "is that purchasers have come to understand the mark as indicating the origin of the wares, so that its use by

a second producer amounts to an attempt to sell his as those of his competitor." *United Drug Co.*, 248 U.S. at 100. The Seventh Circuit's decision comports with the letter and spirit of our federal trademark law, and nearly one hundred years of precedent.

Petitioner does not dispute the finding that by February 1995 the public associated the name ST. LOUIS RAMS with Respondents. Rather, Petitioner contends that the public's and the media's widespread adoption and use of ST. LOUIS RAMS — to refer to the Rams organization — was not use *by* Respondents, and therefore should be disregarded. Petitioner argues, without support, that *National Cable Television Ass'n., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1577-78 (Fed. Cir. 1991), should be "updated, distinguished or rejected". Petition at 11.

In *National Cable Television*, the Federal Circuit observed that

> even without use directly by the claimant of the rights, the courts and the [Trademark Trial and Appeal] Board generally have recognized that abbreviations and nicknames of trademarks or names used only by the public give rise to protectable rights in the owners of the trade name or mark which the public modified.

937 F.2d at 1577-78 (citations omitted). This principle has wide support because the primary objective of our trademark law is to protect against consumer confusion. *See United Drug Co.*, 248 U.S. at 100; J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 7:18 (3d ed. & Supp. 1999). Once a name or nickname becomes associated

with a particular entity as a result of use by consumers, the trade and the news media, this use inures to the benefit of that entity and use by another is likely to cause confusion.[3]

The Seventh Circuit determined that Respondents have priority in the mark ST. LOUIS RAMS as a result, *inter alia*, of the public's and the media's extensive use of ST. LOUIS RAMS to designate Respondents' professional football team. This holding is consistent with an established line of cases cited with approval by the Federal Circuit in *National Cable*, which was decided after the amendments to the Lanham Act upon which Petitioner relies. *Id.*, 937 F.2d at 1577-78 n.3. The Seventh Circuit's recognition of rights created by public use is also consistent with the post amendment decision in *Maryland Stadium Auth. v. Becker*, 806 F. Supp. 1236 (D. Md. 1992). There, the District Court of Maryland held that promotional events or media coverage may satisfy the requirement of "adoption and use" sufficient to vest trademark rights, and that the public sale of a product is not the only means by which sufficient use may be established. *Id.*, 806 F. Supp. at 1239. Respondents' long established rights in the mark "Rams" for a professional football team and related merchandise, combined with the substantial use of ST. LOUIS RAMS by the public and media to designate the same team, was more than sufficient "use" upon which the District Court and Seventh Circuit determined Respondents' priority.

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3. Petitioner claims that this is a "reverse confusion" case and because it is the "little guy", it is somehow entitled to use the ST. LOUIS RAMS mark . Petition at 21-22. This is not, however, a reverse confusion case because Respondents used the mark ST. LOUIS RAMS prior to any commercial use by Petitioner and prior to the filing date of Petitioner's intent to use application.

IV. PETITIONER RAISES NO VALID CONSTITUTIONAL ARGUMENTS THAT WARRANT REVIEW BY THIS COURT.

Petitioner's various Constitutional arguments are meritless. Petitioner first summarily contends that he has been improperly denied a jury trial "to see whether he has statutory priority as of March 10, 1995, or otherwise filed in good faith." Petition at 19. Petitioner, however, failed to establish a genuine issue of material fact as to any of the elements of its claims. Summary judgment, as this Court has repeatedly held, is "not . . . a disfavored shortcut, but rather . . . an integral part of the Federal Rules as a whole which are designed to secure the just, speedy and inexpensive determination of every action." *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986). Entry of summary judgment did not violate Petitioner's right to a jury trial.

Petitioner's next contention, that the Seventh Circuit has unconstitutionally disregarded the Trademark Law Revision Act by "creat[ing] rights for [a] larger compan[y] contrary to a federal statute," (Petition at 20), is similarly baseless. As demonstrated above, the District Court and the Seventh Circuit did not make new law in this case. Respondents were properly held to have priority in the mark ST. LOUIS RAMS by reason of use and association of the name to designate the Rams team, *before* Petitioner filed its intent-to-use trademark application. Contrary to Petitioner's suggestions, the Seventh Circuit's application of the federal statute followed established precedent.

Petitioner's assertion of a violation of his "right" "to use and file [intent to use trademark applications] for the name St. Louis Rams," (Petition at 22-23), is misguided. As the Seventh Circuit found, Petitioner's "right" is subordinate to Respondents' prior established trademark rights.

CONCLUSION

Contrary to Petitioner's convoluted assertions, this is a routine trademark case in which the Seventh Circuit properly applied the law to the facts. There is no important question of federal law or policy to address, and no conflict with other Circuit Courts of Appeal. Petitioner's intent to use trademark application was correctly held subordinate to Respondents' rights arising from prior use of the mark. Finally, Petitioner's submission violated this Court's rules with respect to filing deadlines. For these reasons, the Petition for a writ of certiorari should be denied.

Respectfully submitted,

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